

Application Serial No. 10/071,453
Response to March 23, 2005 OA

MI22-1921

REMARKS

Claim 34 is amended. The amendment to claim 34 **is not** related to the statutory requirements of patentability. Moreover, the amendment made to claim 34 now more positively expresses limitations which were previously inherent in such claim, and accordingly, are not for the purpose of narrowing and do not effectively narrow the scope of the claim.

The Examiner is requiring restriction under 35 U.S.C. §121 to elect a single disclosed species between: Species 1, claims 34-40, pertaining to a device having a plurality of active areas defined by STI having different widths with gate lines disposed thereon to create transistors having different threshold voltages; Species 2, claims 44-48, pertaining to a device with a sub-area having a width different from the one with which has a gate line extended therefore to define separate transistors; and, Species 3, claims 49-62, pertaining to a device including a common gate line which extends over a plurality of sub-areas, each of which is no greater than one micron to create a plurality of transistors being joined in parallel to provide a pull down circuit.

The restriction requirement is improper, and therefore, Applicant respectfully traverses the restriction requirement for the following reasons.

Applicant submits that the election is improper pursuant to MPEP §806.04(e) (8th ed., revision no. 2) which provides that *claims are definitions of inventions and **claims are never species.** To the contrary, species are always*

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specifically different embodiments. Despite the language of MPEP §806, the Office improperly sets forth the alleged grouping of species based upon the sets of claims. Applicant requests withdrawal of the election requirement or identification of the alleged different embodiments in accordance with the MPEP.

Moreover, *no claims have been presented which were not previously examined.* Applicants refer the Examiner to MPEP §808.02 (8th ed., revision no. 2) entitled Related Inventions. It is stated in such MPEP section that where related inventions as claimed are shown to be distinct under MPEP §806.05(c) (the alleged section or rationale for issuing the restriction requirement in the subject application), *the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (a) separate classification, (b) separate status in the art when they are classifiable together, or (c) a different field of search.* It is further stated in MPEP §808.02 that *where the classification is the same and field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist dividing among related inventions.*

The restriction requirement issued March 23, 2005 is entirely devoid of identifying any indication of separate future classification or field of search let alone clear indication as required. Page 2 of the Office Action states that the inventions are distinct with absolutely no support provided. Section B of MPEP §808.02 states that separate status in the art may be shown by citing patents

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which are evidence of such separate status, and also separate field of search. *No patents have been cited or other evidence offered to indicate the alleged separate status. In addition no separate field of search is required inasmuch as all pending claims, except for dependent claims 60-62, were examined on the merits as indicated by the Office Action of July 13, 2004, and the claims were rejected over the prior art. There is no indication that a different classification is provided or a different field of search is required. No clear indication of separate future classification and field of search is provided. As mandated by MPEP §808.02, no reasons exist for dividing among related inventions.*

Additionally, the subject matter of the respective grouping of claims provided by the Examiner are incorrectly described. For example, the alleged subject matter of claims 49-62 is stated to be directed to, among other things, "a plurality of sub-areas" (pg. 2 of paper no. 031505). However, claims 51, 55, 58 and 60 **do not** recite to "sub-areas", and therefore, can not possibly be stated to be directed to such subject matter.

Regarding the Examiner's grouping of claims 34-40, the Examiner incorrectly stated the subject matter of independent claim 34. Applicant has amended independent claim 34 to clarify the subject matter of such claim.

Applicant also refers the Office to MPEP §811 (8th ed., revision no. 2) stating that before making a requirement **after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction**

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Is not required. The Examiner has already searched all pending claims (except for dependent claims 60-62) which are now the subject of restriction. Accordingly, now requiring elimination of any set of claims will not reduce the scope of searching, and thus there are no efficiencies gained by imposing a restriction requirement. In no fair interpretation may the re-examination of the pending already examined claims be considered to be a serious burden as required. The claims (except dependent claims 60-62) have already been considered by the Office, searched and rejected over the prior art. There is absolutely no serious burden to the Office in consideration of the already-examined and previously rejected claimed subject matter.

Additionally, this application is a continuation. The collective subject matter has therefore already been searched in the parent applications. Accordingly, there are no searching efficiencies gained by invoking restriction now at this overly late date. Restriction at this late time is not timely, and does not have any sense of fairness to Applicant.

Still further, there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs

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associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

For at least these reasons, Applicant respectfully asserts that the Examiner's restriction requirement is improper, and requests that the Examiner withdraw the restriction requirement and consider the already examined claims in this application at this time. In the event the restriction is not withdrawn, Applicant provisionally elects Species 3, claims 49-62.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 4-25-05By: 

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